

**REMARKS**

In the Office Action, the Examiner indicated that claims 1, 3-11 and 13 are pending in the application and the Examiner rejected all pending claims.

**Claim Rejections, 35 U.S.C. §102**

In item 4 on pages 2-4 of the Office Action, the Examiner rejected claims 1,3-5,9-11 and 13 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,938,216 to Ishitaki.

**Rejection of Claims 6-8 under 35 U.S.C. §103(a)**

On page 4 of the Office Action, the Examiner rejected claims 6-8 under 35 U.S.C. §103(a) as being unpatentable over Ishitaki in view of U.S. Patent No. 6,121,968 to Arcuri et al. ("Arcuri")

**The Present Invention**

The present invention is a customizable "hot list" used in connection with drop-down list boxes on web-based forms. The user can select, manually, which items are to be included in the customizable hot list. The customizable hot list appears on the user's screen when activated, e.g., when a drop-down list box is clicked with the right mouse button. This hot list presents a subset of the items contained within the drop-down list box, as selected by the user. The content of the hot list is determined manually, entirely by the user, via configuration of a "Preferences" menu option.

**U.S. Patent No. 6,938,216 to Ishitaki**

U.S. Patent No. 6,938,216 to Ishitaki teaches a graphical user interface (GUI) for a computer system that reduces the amount of manipulation of an input device required in accessing a selected item on a menu. The GUI displays a selected menu on the display screen on the basis of the number of consecutive actuations of the input device, such as a mouse button, in a predetermined time interval, or a duration time of an actuation of the input device, such as holding a mouse button down for a period of time. A predetermined sequence of menus can be selected which the user will step through one at a time, or a single menu can be divided into two or more parts which are then separately selected by consecutive actuations of the input device, or continuous actuation of the input device for a predetermined period of time.

**U.S. Patent No. 6,121,968 to Arcuri et al.**

U.S. Patent No. 6,121,968 to Arcuri et al. ("Arcuri") teaches a two-state drop-down menu comprising a short menu state and a long menu state. The short menu comprises a list of executable commands which are a subset of the total number of executable commands available under the selected menu. The short menu may be dynamically expanded into a long menu which will contain a list of the complete set of executable commands available under the selected menu. The short menu adapts to the personal needs of the user, based upon the user's use (or lack thereof) of the executable commands available. Thus, the selection of an executable command

for execution automatically places that executable command on the short list (or maintains it on the list if it was there already), where it remains for a period of time associated with continued use of the selected executable command relative to the operation of the drop-down menus themselves.

**The Cited Prior Art Does Not Anticipate the Claimed Invention**

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”  
MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

**The Examiner Has Not Established a *prima facie* Case of Anticipation**

As noted above, the present claimed invention includes the feature of allowing a user to customize a menu by manually adding selectable items to be included in the menu. Specifically, claim 1 states:

“wherein the items to be included in said subset of items are manually selectable by a user of said GUI.”

Each additional independent claim (9, 11, and 13) includes a variation of this limitation. This feature allows a user to completely customize a menu, only including the features the user specifically desires to be present in the menu. This feature is beneficial in the fact that it allows users

to create custom menus that contain the items that will be of interest to them. This customization feature defines the present claimed invention as novel over the prior art, including Ishitaki.

Ishitaki focuses on how pop-up menus are triggered to appear rather than the content of the pop-up menu itself. In the portion repeatedly cited by the Examiner (col 5 lines 3-34), Ishitaki only discusses the triggering of the menus, detailing how the number of successive clicks of a mouse button, or how the duration of a click of a mouse button is used as a determination factor in deciding which pop-up menu is generated. Ishitaki, however, fails to teach or suggest a user having the ability to determine which selectable items are included in the pop-up menu. The user is only given the option to re-order the items in the menu, not manually add new items to the menu. Col 9, lines 57-65 of Ishitaki state:

“The interface **1540** (FIG. 12B) is used to re-order the items of a selected menu. In other words, interface **1540** enables the user to modify the sequence in which items in each menu are displayed. Window **1560** reflects the current (default) order of the menu items and window **1570** reflects the newly defined order. The user re-orders the items using arrows **1581**, **1582**, and either saves the order by clicking on the set button **1591** or cancels using cancel button **1592**.”

Ishitaki allows the user to re-order the items presented in the menu, but not add a selectable item to the pop-up menu.

Since Ishitaki does not teach or suggest this feature of allowing a user to manually add a selectable item to a menu, and since this feature is specifically claimed in independent claims 1, 9, 11 and 13, it is submitted that the rejections of claims 1,9,11 and 13 under 35 U.S.C. §102 based upon Ishitaki is inappropriate. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Ishitaki and are in condition for allowance.

**The Examiner has not Established a *prima facie* Case of Obviousness**

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

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The Examiner relies upon U.S. Patent No. 6,121,968 to Arcuri to teach presently claimed limitations that Ishitaki fails to teach or reasonably suggest, specifically including a method of determining items to be included on the pop-up menu based on recently selected items by the user. The Examiner uses the combination of Ishitaki in view of Arcuri to reject claims 6-8 under 35 U.S.C. 103(a). However, claims 6-8 are dependent on claim 1. As noted above, Ishitaki contains no teaching or suggestion of manual user selection of items to appear in a hot list or, as discussed by Ishitaki, a pop-up menu. Similarly, Arcuri contains no teaching or suggestion of manual user selection of items to appear in a pop-up menu. Without such teaching or suggestion, any claims containing this element patentably define over Ishitaki in view of Arcuri.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 6-8 under 35 U.S.C. 103 (a) based on the combination of Ishitaki in view of Arcuri.

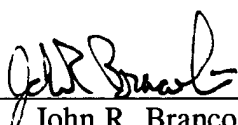
**Conclusion**

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted

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Date

  
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